

Serial No. 09/904,794

### **REMARKS**

It is respectfully requested that French et al. (6,284,294) utilized in the rejection of the claims be listed on Form PTO-892 so that consideration thereof is indicated on the face of the issued patent based upon the above application.

The undersigned wishes to extend appreciation to Examiner Weinstein for the courtesies extended in a telephonic interview on February 8, 2005. The substance of that telephonic interview is hereby confirmed and expanded upon.

Claim 21 was amended in the Amendment filed June 30, 2004 in a manner to recite the subject matter recognized by Examiner Weinstein to involve novelty and inventive step in the International Preliminary Examining Report. It is believed that the Examiner is now reading the claims in a different manner than considered in the PCT prosecution. Although it could be argued that Examiner Weinstein was correct in his reading in the PCT application and that the terms of the claims must be construed within the context of the drawings and description, claim 21 has been amended in a manner to further define the present invention in a manner to distinguish over the prior art to advance prosecution of the application.

Particularly, Friedman discloses introduction of flowing material 62 through a plurality of outwardly extending tubular injection tubes 54 of circular cross sections and a plurality of outwardly extending tubular injection tubes 56 of square cross section. It appears that the flowing material is introduced parallel to the flow direction and spaced from the outer wall defining the chamber 52.

It should be appreciated that injection tubes 54 and 56 of Friedman would present ledges behind which flow of food can build up which is specifically taught as disadvantageous at least at page 8, line 17 and following of the present application. Although it is believed that injection tubes 54 and 56 of Friedman would not be considered ducts or formed in the supply tube, claim 21 as amended clearly distinguishes the recited ducts over the injection tubes 54 and 56 of Friedman.

Kinney discloses three product streams including a first introduced through conduit 45 between dividers 52 and 53, a second introduced through conduit 46 between dividers 53 and 54, and a third introduced through conduit 57 between dividers 52 and 54. In all three cases, flow would be to the left end in Figure 4. Diverter 72 diverts first product from between dividers 52 and 53 into the third product flowing between dividers 52 and 54. Diverter 73 diverts second

Serial No. 09/904,794

product flowing from between dividers 53 and 54 into the first product flowing between dividers 52 and 53. Diverter 74 diverts third product from between dividers 52 and 54 into the second product flowing between dividers 53 and 54 (see Figure 6). The Examiner appeared to contend that flow would also occur in the opposite direction (as an example from between dividers 52 and 54 into the flow between dividers 52 and 53). However, this is clearly contrary to what is drawn in Figures 6 (with Figure 7 representing the marbled product produced and not a representation of the introduction during operation). Thus, any support for such a contention should be identified in Kinney. Further, it is respectfully submitted that the diverters 72-74 of Kinney would present ledges or create blocking (which is also expressly taught as being undesirable at least at page 9, lines 17 and 18 of the present application). It is respectfully submitted that Friedman and Kinney teach alternate forms of operation. Where is it suggested in Friedman and/or Kinney that the respective teachings of each have application in the other form of structure and operation? If anything, a person skilled in the art would replace the injection tubes 54 and 56 of Friedman with the diverters 72-74 of Kinney, but such modification would still not meet the recitations of the claims existing in this application.

In addition to defining the ducts in a manner to distinguish over the prior art, recitations have been added defining the function of the recited differences in structure of the present invention over the prior art, with such recitations being suggested by Examiner Weinstein since the claims existing in this application are method claims.

The remaining references, Gundlach, French and Mannara were not mentioned in the November 8, 2004 Office action, and none of the points raised in the June 30, 2004 in regard thereto were responded to by Examiner Weinstein. Further, during the telephonic conference, Examiner Weinstein reviewed the remaining prior art and did not raise any other points against inventive step of the present invention. However, for completeness, Gundlach (commonly assigned as Friedman) discloses injection tubes 117 of the same type as Friedman. Likewise French discloses a nozzle 9 having the same deficiency as Friedman (but which also rotates). As extensively set forth in the June 30, 2004 Amendment, Mannara is directed to a different structure and operation than the present invention and would not suggest to a person skilled in the art the recitations of the claims as amended.

For completeness, the Examiner contends:

Serial No. 09/904,794

The basic issue is whether the art taken as a whole teach the passageway of the duct extending opposite to the flow direction. Thus recitation is seen to have been an obvious matter of design.

In this regard, it is respectfully requested that the Examiner identify where the art teaches or in any way suggests "the supply tube configured so that its secondary material is admitted in a direction away from the flow direction" contended by the Examiner. In any case, it is respectfully submitted that the Examiner, relying upon a collection of five references in an attempt to meet the recitations of the claims, basically contents that when "taken as a whole", the prior art could be combined/modified to arrive at the present invention. As set forth in In re Fine, 5 USPQ2d 1596, 1599 (CAFC 1988):

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." (case citation) But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." (case citation) And "teachings of references can be combined only if there is some suggestion or incentive to do so." (case citation) Here, the prior art contains none. (emphasis theirs)

Further, the CAFC in *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 U.S.P.Q. 763, 771 (1984) quoted:

A patentable invention \*\*\* may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

Similarly, the Court of Appeals for the Federal Circuit *In re Sernaker*, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art,

Serial No. 09/904,794

that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

As it has been clearly shown that the prior art does not provide any suggestion or incentive to combine the various elements in an attempt to meet the recitations of the claims, it is respectfully submitted that the rejection of the claims based upon the prior art has been overcome. Favorable reconsideration is respectfully requested.

Additionally, it is respectfully submitted that "obvious matter of design" is not a proper ground of rejection. Specifically, as stated by the Patent Office Board of Appeals in *Ex parte Dere*, 118 U.S.P.Q. 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as *In re Newell*, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Serial No. 09/904,794

Particularly, as set forth *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

The present application expressly teaches that the ducts as recited in the claims have advantageous results at least at page 9, line 18 and following of the present application. It is then respectfully submitted that the prior art does not in any way support that applicants' "variations" are within the level of ordinary skill in the art. The only suggestion of the recited construction and arrangement is the hindsight knowledge of the present invention. The Examiner has not provided any prior art evidence supporting his contention, with such evidence being indicated by the Court of Appeals for the Federal Circuit as being needed to support the present rejection. It is then respectfully submitted that the Examiner must present prior art evidence showing that the modifications that the Examiner apparently concedes are not suggested by the references applied in this official action would be a "choice" to a person skilled in the art.

In the March 31, 2004 Office communication, the Examiner has cited the United States Patents listed in NOTICE OF REFERENCES CITED as G-M of Page 1 of 3, A-M of Page 2 of 3 and A-C of Page 3 of 3 and indicated consideration of the prior art cited by applicants. By the lack of application of these references and others like then within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of the references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' food products, especially refrigerated yogurt products, and apparatus and methods for their production which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and by the applicants, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 21-29 and 32-54, as amended, of the present application and to pass this application to issue.

Serial No. 09/904,794

If the present amendment does not place the above application in condition for allowance, a further interview with Examiner Weinstein by telephone or in person is respectfully requested.

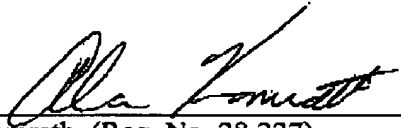
Respectfully submitted,

Robert Germick, et al.

Dated: February \_\_\_\_, 2005

By: \_\_\_\_\_  
Annette Frawley, Esq.  
GENERAL MILLS, INC.  
P.O. Box 1113  
Minneapolis, MN 55440  
Tel: (763) 764-4158  
Fax: (763) 764-2268

Dated: February 11, 2005

By:  \_\_\_\_\_  
Alan D. Kamrath (Reg. No. 28,227)  
NIKOLAI & MERSEREAU, P.A.  
900 Second Avenue South, Suite 820  
Minneapolis, MN 55402  
Tel: (612) 392-7306  
Fax: (612) 349-6556